



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Rose
10-4-99

APPLICANT: Salvador L. Arias et al.
SERIAL NO.: 08/994,531 GROUP ART UNIT: 2711
FILED: December 19, 1997 EXAMINER: C. Grant
FOR: ASYMMETRICAL DATA
COMMUNICATION SYSTEM

Assistant Commissioner for
Patents
Washington, D.C. 20231

ATTORNEY DOCKET NO.: 36968/172908

I hereby certify that this correspondence is being deposited with the
United States Postal Service as certified first class mail in an envelope
addressed to: Assistant Commissioner for Patents, Washington, D.C.
20231, on September 22, 1999.

Janie Wilkins

DATE: September 22, 1999

SUPPLEMENTAL AMENDMENT

Sir:

This Amendment is in response to a Communication dated September 13, 1999, in which the Examiner held the previously submitted response to be non-responsive. This Amendment incorporates by reference the entire response filed on June 24, 1999, and supplements that response with the following remarks. The Examiner is respectfully requested to reconsider and reexamine the non-final Office Action of December 24, 1998 (Paper No. 5) in light of the previously submitted response and in light of this Supplemental Amendment.

The Examiner is thanked for clarifying the Communication during our telephone conversation on September 15, 1999. The Examiner explained that the response filed on June 24, 1999, did not contain an adequate statement as to why the newly added claims were allowable. Although the response did point out that Mr. Grant had already

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allowed the claims in a parent application, Mr. Grant believed that a statement specifically distinguishing the claims from the other references was necessary.

To expand upon the statement in the prior response, the Examiner issued an Office Action on June 16, 1997, in parent application Serial No. 08/447,537 in which he allowed claims 22 to 34. Among other references, the Examiner had considered U.S. Patent No. 5,563,892 to Kostreski et al. ("Kostreski") and U.S. Patent No. 5,600,364 to Hendricks et al. ("Hendricks"). In this Office Action, the Examiner determined that claims 22 to 31 are allowable "because the prior art fails to disclose or suggest a system for communicating comprising a digital tuner for receiving digital UHF transmissions and an analog tuner as recited in the claims." The Examiner determined that claims 32 to 34 were allowable because "the prior art fails to disclose or suggest a method of providing asymmetric data communication services comprising the steps of receiving the PSTN message from a subscriber and retransmitting to other service providers as recited in the claims."

The present application was filed in order to pursue claims that had been rejected in parent application Serial No. 08/447,537. The issue fee had been paid and the application was ready to issue with allowed claims 22 to 34. The parent application, however, was subsequently abandoned so that the Examiner could have the benefit of ascertaining the patentability of all claims in light of some additional patents. Consequently, after the abandonment of the parent application, allowed claims 22 to 34 which had been in the parent application were introduced to the present application as new claims 35 to 47.

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Since the Examiner allowed claims 22 to 34 in the parent application, the Examiner has already determined that the subject matter of claims 35 to 47 is allowable over the prior art of record in the parent application. Thus, claims 35 to 47 are allowable over, *inter alia*, the patents to Kostreski and Hendricks, which were the only references relied upon by the Examiner in rejecting claims in the non-final Office Action of December 24, 1998.

Furthermore, the newly added claims 35 to 47 are allowable over all references cited in the present application and not just those cited in the parent application. The claims, for instance, are allowable over the newly cited references, including U.S. Patent No. 4,747,160 to Bossard and U.S. Patent No. 5,668,610 to Bossard et al., at least because the references do not teach or suggest "a digital tuner for receiving digital UHF transmissions and an analog tuner as recited in the claims" nor do they teach or suggest a "method of providing asymmetric data communication services comprising the steps of receiving the PSTN message from a subscriber and retransmitting to other service providers as recited in the claims."

This Supplemental Amendment together with the response filed on June 24, 1999, are fully responsive to the non-final Office Action of December 24, 1998. As set forth in 37 C.F.R. § 1.111(b), which is repeated at M.P.E.P. § 714.02, a reply to an Office action "must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any **applied** references" (emphasis added). The only references that the Examiner **applied** in the Office Action were the Kostreski and Hendricks patents. The Examiner has already determined that the subject

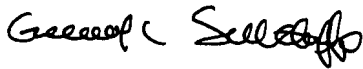
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matter of the new claims was allowable over these references whereby the statement to this effect in the prior response was completely responsive. Moreover, in addition to this statement, this Supplemental Amendment presents examples of some additional reasons as to why the claims are allowable over the applied references and other cited references.

For at least the above reasons and for the reasons in the amendment of June 24, 1999, claims 1 to 15 and 32 to 47 are now in condition for allowance. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is encouraged to telephone the undersigned at (404) 815-6530.

Please charge any additional fees or credit any overpayment to Deposit Order
Account No. 11-0855.

Respectfully submitted,


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